

REMARKS

No further amendments are presented.

Claims 1-16 are pending in the application. Claims 1, 2, 4-11, 14, and 16 were rejected. Claims 3, 12, 13, and 15 were objected to.

If any extension of time is required, please consider this paper a petition for the total extension of time required.

It is believed that no fee is due in connection with this paper. In the event that a fee is due, kindly refer to the general Deposit Account Authorization previously filed with the application.

For the reasons explained below, it is respectfully submitted that all Claims are novel over the Vaidya *et al.* presentation.

Three Key Points Appear to be Undisputed.

The Applicants' earlier, March 7, 2008 Response gave a detailed explanation of the following three points, none of which has been questioned by the Office:

- (1) The Vaidya *et al.* presentation represented the inventors' own work.
- (2) The substance of the Vaidya *et al.* presentation was duplicated – in its entirety – in the disclosure of the provisional application from which priority is now claimed.
- (3) The Vaidya *et al.* presentation was published less than one year before the priority provisional filing date, and therefore it may not be cited against those claims that are supported by the provisional disclosure.

Nothing in the June 13, 2008 Office Action questioned any of these three points.

The §102(b) Rejection is *Necessarily* Inconsistent with the Undisputed Facts

The sole ground of rejection was that some of the claims were said to be anticipated by the Vaidya *et al.* presentation under 35 U.S.C. §102(b). It is respectfully submitted that this rejection is ***necessarily*** inconsistent with the undisputed facts.

A Time Line of the Key Events

The following dates and facts are undisputed:

November 2002. Vaidya *et al.* presentation. The authors of the presentation are identical to the inventors on both the provisional patent application and the nonprovisional patent application.

March 2003. Provisional filing date. The disclosure of the provisional application includes everything of substance from the November 2002 presentation. (To review the underlying details, see pp. 5, 7, and 8 of Applicants' March 7, 2008 Response.)

December 2003. Nonprovisional filing date. The benefit of the March 2003 provisional filing date was properly claimed.

It would be a logical impossibility for the Vaidya *et al.* presentation to teach a claim limitation that is not also taught by the provisional disclosure. The M.P.E.P. clearly supports this conclusion.

Several Claims were rejected under §102(b) as being anticipated by the Vaidya *et al.* presentation. Because the December 2003 nonprovisional filing date was more than one year after the November 2002 presentation date, the Office concluded that the November 2002 presentation could be cited as a reference under § 102(b).

To make this rejection the Office, of necessity, had to assert that there existed at least one claim limitation that was not supported by the March 2003 provisional disclosure,

but only by the later, December 2003 nonprovisional disclosure. Otherwise, there could be no anticipation by the inventors' own work.

It is undisputed that the substance of the Vaidya *et al.* presentation is contained – in its entirety – within the disclosure of the March 2003 provisional application.

But the statements in the preceding two paragraphs are ***necessarily*** inconsistent. It is a logical contradiction that the Vaidya *et al.* presentation could teach a claim limitation that is not also taught by the provisional disclosure, for the simple reason that everything of substance in the Vaidya *et al.* presentation is also contained within the provisional disclosure.

The June 13, 2008 Office Action at page 4, asserted that the M.P.E.P. did not support the Applicants' conclusion:

Applicants argue that a teaching from the publication (Vaidya et al, November 2002) cannot anticipate the present invention because the identical teaching is also found in the provisional disclosure filed on March 27, 2003. The Examiner disagrees. MPEP does not provide support for such argument. Instead, MPEP states the following; "If the application properly claims benefit under 35 U.S.C. 119(e) to a provisional application, the effective filing date is the filing date of the provisional application for any claims which are ***fully supported*** under the first paragraph of 35 U.S.C. 112 by the provisional application." See MPEP 706.02,VI (D). Since the provisional application does not provide support for the present limitations (iii) and (iv) of claim 1, the effect filing date of present application is December 12, 2003, and thus previous 102(b) rejection over Vaidya publication still stands.

(emphasis in original)

With all respect, the Office's reliance upon, and citation of pertinent sections of the M.P.E.P. was incomplete. While M.P.E.P. § 706.02 is certainly pertinent, so is § 2131, and perhaps § 2163.07(a) as well.

Applicants are in complete agreement with the proposition that a nonprovisional application may only properly claim the benefit of a provisional filing date for claims that are fully supported by the provisional application under 35 U.S.C. § 112, first paragraph. That is not in dispute. But neither does that proposition, standing alone, answer the question.

M.P.E.P. § 2131 is highly pertinent. It states in part:

To anticipate a claim, the reference must teach every element of the claim. A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. . . . The identical invention must be shown in as complete detail as is contained in the ... claim.

(citations omitted; bold heading in original)

The rejection of Claim 1 as being anticipated by the Vaidya *et al.* presentation is equivalent to an assertion that each and every element of Claim 1 is found within the Vaidya *et al.* presentation, in as complete detail as is contained in Claim 1.

Hypothetically, if one assumed (strictly for the sake of argument) that the Office Action was correct in saying that Claim 1 is not entitled to the benefit of the March 2003 provisional filing date, because the provisional application did not support limitations (iii) and (iv) of Claim 1, then it would also **necessarily** be true that the Vaidya *et al.* presentation did not teach those limitations either. Because everything of substance in the Vaidya *et al.* presentation is also found in the provisional disclosure, it follows – as a matter of logical necessity – that what was not taught by the provisional disclosure **necessarily** cannot be taught by the Vaidya *et al.* presentation.

Where a limitation is not taught by the Vaidya *et al.* presentation, it **necessarily** follows that the presentation cannot anticipate the Claims. See M.P.E.P. § 2131.

Considerations of Possible “Inherent” Disclosure Do Not Alter these Conclusions.

Page 3 of the June 13, 2008 Office Action appears to suggest that limitations (iii) and (iv) of Claim 1 are inherently disclosed by the Vaidya *et al.* presentation. Hypothetically, if one assumed (strictly for the sake of argument), that the Office had intended to assert that these limitations were insufficiently disclosed in the provisional application for Claim 1 to be entitled to the benefit of the provisional filing date; and that the Office had also intended to assert that the same limitations were nevertheless inherently

taught by the Vaidya *et al.* presentation, and thus that the presentation anticipated the claimed inventions; then it is respectfully asserted that those positions would be mutually contradictory, and that the rejection must be withdrawn as being **necessarily** self-inconsistent.¹

M.P.E.P. § 2131 states that for a reference to anticipate a claimed invention, the identical invention must be shown in as complete detail in the reference as is contained in the claim. If an inherent disclosure suffices to anticipate, then the same inherent disclosure suffices to support the claim. Conversely, if an inherent disclosure is insufficient to support a claim, then the same disclosure would be insufficient to anticipate. See also M.P.E.P. § 2163.07(a):

By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter.

Thus if one assumed (for the sake of argument) that the Office Action had intended to assert that certain limitations were inherently disclosed in the Vaidya *et al.* presentation, and if one further assumed that such an assertion would be correct, then under M.P.E.P. § 2163.07(a) it would, **necessarily**, also be the case that the provisional disclosure would adequately support the same limitations.

Thus the Vaidya *et al.* presentation **necessarily** cannot anticipate any of the claimed inventions. To the extent that the presentation otherwise teaches a claimed invention, whether expressly or inherently, the present application is entitled to the benefit of a provisional filing date within twelve months of the date of the presentation, a provisional application that includes the same teachings. To the extent that some aspect of the claimed invention is not entitled to the benefit of the provisional filing date, then it

¹Note that it is not necessary for the time being to address the question of “inherency” on the merits. For now it suffices to observe that the anticipation rejection is based on an internal inconsistency. Because the rejection is internally inconsistent, it must be withdrawn.

also, ***necessarily***, is not taught by the Vaidya *et al.* disclosure, and again that presentation ***necessarily*** cannot anticipate.

**The Position Advocated Here is Consistent with the Policies
Underlying Provisional Applications. The Prior Art Rejection Is Not.**

For the reasons given above, it is respectfully submitted that all Claims are ***necessarily*** novel over the Vaidya *et al.* presentation.

It may be worth noting that this conclusion represents more than just the outcome of an exercise in word-play and logical niceties. It is completely consistent with the policies underlying provisional applications, and with the common understanding of the role that provisional applications play in the United States patent system. An experienced inventor, who has some prior experience with the patent system, but who is not himself or herself a patent practitioner, might (hypothetically) phrase his or her understanding like this:

“Your own publication cannot be cited against you, as long as you take that publication and file it as a provisional application within twelve months.”

The above (hypothetical) summary may not capture every subtlety; but it is, nevertheless, a good approximation. A lengthier, but slightly more accurate statement of the conclusion reached here might be:

Where the inventors have made a publication of their own work and, within twelve months of the publication date, the same inventors file a provisional application that copies, in substance, everything pertinent from the publication – then that publication may not be cited as a reference against a nonprovisional application that is filed by the same inventors and that properly claims priority from the provisional application.

This result is imminently fair. It is in complete accord with the policies underlying § 119(e) and § 102(b). And – unlike the position reflected in the recent Office Actions – this result would not have the unhappy result of upsetting common understandings within the

community of users of the United States patent system, and of upsetting their reliance upon those understandings.

Provisional applications sometimes must be filed on very short notice. Section 119(e) was, among other things, designed specifically to accommodate last-minute filings, and to dispense with nearly all the formalities that are ordinarily required in patent applications.

This goal would be thwarted if, as the prior office actions have suggested, an inventor's own publication could be cited as anticipating a nonprovisional application, even though a provisional application had been filed within twelve months of the publication date, and even though the provisional application had copied everything from the publication.²

Another, closely related policy that underlies provisional applications is to allow ample time for inventors to prepare and file a complete, formally proper, nonprovisional application. Consider the following hypothetical situation, which is identical to the present situation with one exception: Assume that the Vaidya *et al.* presentation had been made in November 2002; and that the authors of the Vaidya *et al.* presentation were the same as the inventors in the present application; but that the application filed in March 2003 had been the present, nonprovisional application, with no intermediate provisional application involved. In that case, the Office would presumably agree that the Vaidya *et al.* presentation could not be cited as anticipating, because it would represent a publication made by the inventors themselves less than twelve months before the (nonprovisional) filing date. What justification exists, what policy reason is there to penalize the inventors of the present patent application, but not those in the hypothetical situation described in this paragraph?

² Note that all arguments presented in the present paper are based on the specific factual situation described. Different factual situations are outside the scope of these arguments. At least for the time being, Applicants take no position as to whether the same conclusion or a different conclusion should apply in other circumstances, such as: **(a)** a publication made by others within the twelve months preceding the provisional filing date; **(b)** a publication whose authors only partially overlap the named inventors in a provisional or nonprovisional patent application; or **(c)** a provisional application that copies part, but not all, of the pertinent disclosure of the inventors' earlier publication. Those hypothetical situations are not present here.

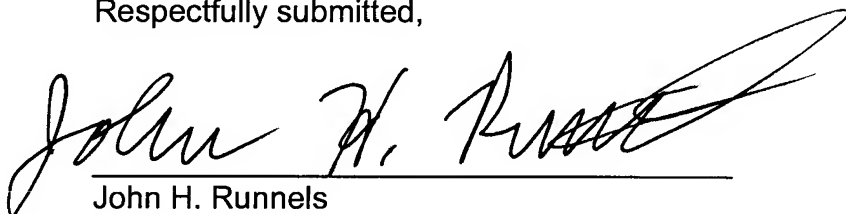
Where time, finances, or other considerations make it impractical or impossible to file a nonprovisional application before a particular deadline, § 119(e) provides a vehicle for inventors to temporarily “stop the clock.” By filing a provisional application, which may dispense with nearly all the formalities that are otherwise required for a patent application, the inventors are granted an additional twelve months to prepare and file a formal, nonprovisional application. The nonprovisional application is entitled to the benefit of the provisional filing date, to the extent that the disclosure of the provisional application supports what is later claimed. But the position taken in the January 2, 2008 and June 13, 2008 Office Actions would have the effect of depriving the Patent Applicants of the benefit of the earlier filing date, contrary to the purposes underlying 35 U.S.C. § 119(e). The position taken by the Office Actions is equivalent to saying that if inventors choose to file an informal, provisional application that copies their own publication (not yet 12 months old), they do so at their own risk. Not just the risks that are inherent in filing any patent application – such as the possibility that unknown prior art by others might be cited against the patent application, or the possibility that the Patent Examiner might reach a different conclusion than the inventors as to what is or is not considered patentable over known prior art. No, there would be an additional risk – namely, that the inventors would lose the benefit of their provisional filing date entirely, and that the Office could cite their own publication against them, even though the provisional filing was made within twelve months of the publication, and even though it copied everything of substance from the publication.

It is respectfully submitted that, once these questions are reconsidered in light of the arguments presented above, the Office will agree that the position taken in the earlier Office Actions would be contrary to both the spirit and the letter of the patent statute, and that the § 102(b) rejection should be withdrawn.

Conclusion

Allowance of Claims 1-16 at an early date is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, reading "John H. Runnels". The signature is fluid and cursive, with a long horizontal stroke at the end.

John H. Runnels
Registration No. 33,451
Taylor, Porter, Brooks & Phillips, L.L.P.
P.O. Box 2471
Baton Rouge, Louisiana 70821
(225) 387-3221

June 24, 2008